IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Johnson et al

Art Unit: 2135

Confirmation No.: 4776

Application No.: 09/367,797

Filed: January 19, 2000

For: INVISIBLE DIGITAL WATERMARKS

VIA ELECTRONIC FILING

Examiner: Paula Klimach

Date: March 22, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants request review of the final rejection of claims 1, 15 and 27 in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

Respectfully submitted,
DIGIMARC CORPORATION

Date: March 22, 2007

Customer Number 23735

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Board will reverse the Examiner's rejection of claims 1, 15 and 27 under § 101. The rejections are ill-founded.

Reference is made to the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, published by the PTO in October, 2005.[1]

Each of the rejected claims produces a useful, concrete, and tangible result.

The claimed arrangements are "useful" for reasons detailed in the specification. For example, the claimed methods and apparatuses can be used with motion pictures, or other media, to prevent or discourage copying of the media data (*e.g.*, by marking the media data with a hidden "do not copy" watermark flag that is recognized and respected by compliant consumer electronic equipment). Or the methods/apparatuses can be used to invisibly convey watermark data with a media signal so as to identify the copyright holder (e.g., Sony Pictures or The Walt Disney Company).

Regarding "concrete," the Guidelines indicate that this test inquires as to whether a "result" can be assured, or whether the claimed arrangement yields an "irreproducible," result. (In the latter case, a rejection under § 112, as calling for "undue experimentation" may be warranted.) In the present case, the claimed methods and apparatuses reliably operate to yield the desired watermarking results.

The result meets the "tangible" requirement because the result is practically applied; it is not a case where a process is disclosed with no practical application.

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[1] http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf .

In her *Response to Arguments,*[2] the Examiner stated

> "[T]he claims may have a concrete result, however, the result is not presented in such a way that it may be useful."

Not so. The application evidences the usefulness of the invention.

The preamble of claim 1 directs it to "A method for inserting identification or authentication data into digital media." The inserting of identifying – or authenticating – data into digital media is a useful result.

This utility is noted, repeatedly, throughout the specification, *e.g.*, at page 1, lines 3-5:

> This invention relates to the provision of identification or authentication data, sometimes referred to as a watermark or signature, in digital media data such as digital image or audio data.

Likewise, the specification explains, at page 1, lines 21-23:

> Watermarks are utilised in media data for a number of reasons, one being to prevent or discourage copying of the media data if it is subject to copyright, or to at least allow for identification of the media data even if it is copied.

Similarly, the specification elaborates, at page 8, lines 24-29:

> This invention relates to the insertion and extraction of identification or authentication data for use as a watermark in digital media data, such as digital image data, still or sequential, digital audio data or the like. A watermark provided in digital media data may provide a means for identification of the source or some other attribute of the media data as may be required to prove copyright ownership, for example. As mentioned above, embodiments of the present invention are designed to have a number of advantageous properties, including...

Especially in the present era (*c.f.,* Viacom's litigation against YouTube), the importance of identifying media data, e.g., to prove copyright, is essentially beyond dispute. Appellants' specification teaches this as one of the uses to which their claimed invention can be put.

The Board will recognize that the Examiner's rejection under § 101 is ill-founded, and will reverse.

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[2] Final Rejection, December 1, 2006, page 2.